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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,743	01/22/2004	Nicolas St.-Germain	13726	5593

7590

09/20/2005

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53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

VY, HUNG T

ART UNIT	PAPER NUMBER
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2821

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/762,743	Applicant(s) ST.-GERMAIN, NICOLAS	
	Examiner Hung T. Vy	Art Unit 2821	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 89/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledges

1. According to the rule USC 1.56 (Duty to disclose information material to patentability), the applicant request to provide the references for consideration. The rule U.S.C 1.56 as below:

1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §

§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

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(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office,

or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application;

and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

Claim Objections

2. Claim 7 is objected to because of the following informalities: what claims that claim 7 depend to. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-16, and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Eckel et al., U.S. patent No. 6,388,399.

Claims 1,4-7,10-16, 21-24 Eckel et al. disclose an intelligent light emitting diode; comprising: a voltage source (70), said voltage source continuously supplying a voltage to said traffic signal (See column 10, line 23-31); an electronic switch (See column 2, line 17-29); an integrated flasher (See column 3, line 7 showing the light control unit to flash light) operatively coupled to the electronic switch to toggle a state of the electronic switch at a predetermined rate; at least one light element (See fig. 14); a power supply (338) for powering the at least one light element (See fig. 14); a dimming interface for dimming the at least one light element (See fig. 11); a controller (340) for generating an appropriate command signal based on one or more status signals (see fig. 14), said status signals comprise one or more of the following: light element current, light element voltage, light output (450) (see fig. 18), input current and input voltage and said appropriate command comprise one or more of the following: an on or off command, a dimming command (See column 3, line 32-43), a flashing command, and an emergency disconnection signal; a light sensor (450) for detecting light output (See fig. 18) of the at least one light element; a voltage detecting circuit (62) for the light element voltage (See column 10, line 36-45), and the output voltage or combinations thereof; and a current

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monitoring circuit (See column 5, line 50-51) for measuring the light element current, the output current, or combinations thereof.

Claims 2-3, Eckel et al. discloses the light sensor is photocell (See fig. 20), one light element is an LED array (344)(See fig. 14).

Claims 8-9, it is inherent that Eckel et al. discloses an emergency disconnect because on column 10, line 31-35, Eckel et al. discloses a momentary contact switch the external power supply, this providing a reset function.

5. Claims 1-2, 4-5, 9, 16, and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lys et al., U.S. pub No. 2004/0212321.

With respect to claims 1, 4-5, 16, and 21-24, Lys et al. discloses an intelligent light emitting diode (LED) module for traffic signal (see paragraph 0067); comprising: an electronic switch that continuously received a voltage from an associated voltage source and conveys the voltage to at least one other component on the LED module (see paragraph 0072 or 0117); a flasher operatively coupled to the electronic switch to toggle a state of the electronic switch at a predetermined rate (See paragraph 0115 (toggle), 0098 (PWM)(PAM)(PCM), 0122(flickering effects)). A power supply that receives power distributed by the electronic switch; at least one LED (104) that is powered by the power supply (500); and a dimming interface operatively coupled to the power supply for dimming the at least one LED (see paragraph 0103); said module generates at least one status signal indicative of one or more of the following current traveling through the at least one LED; a voltage applied across the at least one LED, and light energy emitted from the at least one LED(See paragraph 0098, 0107) and

conveys the at least one status signal to an associated controller that generate a command in response (see paragraph 0103), the command is based the at least one status signal and controls the at least one LED of the LED module, said command, a dimming command (see paragraph 0103)(see fig. 7).

Respect to claim 2, Lys et al. discloses including a light sensor (see paragraph 00101,0107).

Respect to claim 9, Lys et al. disclose wherein the emergency disconnect command opens a circuit supplying power to the at least on LED (See paragraph 0136-0137).

6. Claims 1, 16, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochstein, U.S. patent No. 5,661,645.

With respect to claims 1, 16, and 21, Hochstein discloses an intelligent light emitting diode (LED) module for traffic signal; comprising: an electronic switch (80) that continuously received a voltage from an associated voltage source and conveys the voltage to at least one other component on the LED module (see fig. 7); a flasher (80) operatively coupled to the electronic switch to toggle a state of the electronic switch at a predetermined rate (see fig. 80). A power supply (22) that receives power distributed by the electronic switch; at least one LED (12,14) that is powered by the power supply (22); and a dimming interface operatively coupled to the power supply for dimming the at least one LED (see column 10, line 3-60); said module generates at least one status signal indicative of one or more of the following current traveling through the at least one LED; a voltage (48) applied across the at lest one LED, and conveys the at least

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one status signal to an associated controller that generate a command in response (see column 10, line 62-68 and column 11, line 1-5), the command is based the at least one status signal and controls the at least one LED of the LED module, said command, a dimming command (see column 10, line 62-68 and column 11, line 1-5).

Response to Arguments

7. Applicant's arguments filed on 08/09/2005 have been fully considered but they are not persuasive. Applicant made the following arguments:

“Eckel et al. does not contemplate traffic signals or intelligent traffic signal LED modules for controlling traffic signal LEDs as recited in the subject claims ”
page 9, second paragraph.

In response to Applicant's argument above, the applicant's argument are not persuasive because the recitation contemplate traffic signals or intelligent traffic signal LED modules for controlling traffic signal LEDS has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Examiner requests the applicant's response the acknowledges on rejection 1 above (Duty to disclose information material to patentability).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 14, 2005.
Hung T. Vy
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WILSON LEE
PRIMARY EXAMINER